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| APPLICATION NO.    | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------|-------------|-----------------------|---------------------|------------------|
| 09/397,704         | 09/16/1999  | GERALD Craig ALTOMARE | 6925-196            | 9091             |
| 20583              | 7590        | 10/31/2005            | EXAMINER            |                  |
| JONES DAY          |             |                       | PATEL, JAGDISH      |                  |
| 222 EAST 41ST ST   |             |                       | ART UNIT            |                  |
| NEW YORK, NY 10017 |             |                       | PAPER NUMBER        |                  |

3624

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/397,704 | <b>Applicant(s)</b><br>ALTOMARE ET AL. |  |
|                              | <b>Examiner</b><br>JAGDISH PATEL     | <b>Art Unit</b><br>3624                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) Claims 1, 4, 6-8, 10-12, 14-15, 25, 28-36 and 38-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) Claims 1, 4, 6-8, 10-12, 14-15, 25, 28-36 and 38-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 5/23/2005.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/23/2005 has been entered.

#### ***Drawings***

3. New corrected (clearly readable) drawings in compliance with 37 CFR 1.121(d) are required in this application because certain figures are not legible (Figures, 1-17, and 23A-24F are shaded and have too small print types).

#### ***Response to Amendment***

4. Claims 1, 6-8, 10, 11, 25, 28, 34-36, 38, 41, 43, and 44 have been amended. Claims 1, 4, 6-8, 10-12, 14-15, 25, 28-36 and 38-44 are currently pending.

#### ***Response to Arguments***

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4. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejections.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 6-8, 10, 25, 28-36 and 38-41 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1, recites "information stored in a database" without any specifics of the information. Since, the information stored in the database forms the basis for the set of calculations of steps (a) ..(e), the specific data stored in the database must be identified so as to facilitate the recited calculation steps.

Claim 1 recites "accessing ..information stored in a database to enable ..to periodically" to perform steps (a) through (e). This recitation renders the method claims indefinite because the latter process steps are recited as intended process and not positively recited. It is recommended that each of the aforementioned step be written in the following format:

Storing information in a database information (define the information consistent with the disclosure).

Executing a processing program loaded on a computer, the processing program configured to ...

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Accessing .. the database via the executed program to periodically perform the following steps:

- (a) computing price of the trust units..;
- (b) determining a predetermined threshold price..;
- (c) .. .. . ;
- (d) ..; and
- (e) adjusting the share ratio ..;

Note that independent claims 25 and 28 also contain similar deficiencies.

### ***Claim Rejections - 35 USC § 101***

7. Claims 11,12, 14,15, 42 are deemed non-statutory under 35 USC 101 as explained below. In dependent claim 11 is analyzed.

“computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.” (section 2106 of MPEP).

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Claim 11 recites a "processing program loaded on a computer". However, the functionality of the processing program cannot be realized until acted upon by a processor. The "system" merely recites a single element (a processing program) which cannot or is not capable of performing any process to realize a useful, concrete and tangible result.

***Allowable Subject Matter***

8. The pending claims are deemed allowable over the prior art subject to resolution of claim deficiencies identified in the foregoing paragraph.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

10/26/05